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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,578	03/08/2002	Tsung Ming Ou	USDP1531T-TB	2823

7590 04/02/2003
Raymond Y. CHAN
1050 Oakdale Lane
Arcadia, CA 91006

EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,578

Applicant(s)

OU, TSUNG MING8

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik.

Regarding claims 1 and 3, Kralik discloses an American football construction including a ball cover (14) having four elliptical cover pieces sewn edge to edge together, an inflatable bladder (12) and a construction liner comprising a fabric lining (24) and a sheet material (26) laminated together. Note column 3, lines 12-24 and 33-47 which detail the construction liner. Note particularly the teaching that other materials may be used. It would have been obvious to one of ordinary skill in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

Regarding claim 2, Kralik provides a backing (16) of foaming material. It would have been obvious to one of ordinary skill in the art to form the cover of Kralik from synthetic leather in order to take advantage of synthetic leather's well known physical characteristics.

Regarding claim 4, the claim is a product by process claim wherein the patentability of the product does not depend on its method of production. See MPEP 2113.

Regarding claims 5-8, Kralik provides fabric linings (24, 28) on both sides of the sheet material (26).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik in view of Ou (5,759,123). Ou reveals an American football including a panel formed from rubber and fabric lining. The lining and rubber are vulcanized together to form the panel. It would have

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been obvious to one of ordinary skill in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

Regarding claims 2-8, note the rejections set forth above.

Response to Arguments

Applicant's arguments filed January 21, 2003 have been fully considered but are not deemed to be persuasive. Applicant's argument that Kralik fails to teach a construction liner formed by compressing and vulcanizing a rubber piece and a fabric lining un the fabric lining is integrally united with the rubber piece is noted. However, this limitation is considered to define a product-by-process limitation. Applicant is directed to MPEP 2113 where it has been found that if a product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Here, the end product of Kralik as modified renders the claimed structure obvious even though the process to create the product may be different because both teach a fabric lining and rubber material laminated together.

Regarding the applicant's statement that the instant invention does not have a lamination of layers as shown by Figure 7 of Kralik, the instant claims fail to preclude this structure. Instant claim 1 merely identifies a fabric lining integrally united with a rubber piece to form the construction liner. Clearly, Kralik renders this structure obvious by providing a fabric lining (24) that is laminated together with a sheet material thus, integrally uniting the two layers together.

Regarding the reference to Ou, this reference is relied upon merely for its teaching that it is well known in the art of sports balls to form layers for a sports ball by vulcanizing rubber and fabric linings together. The applicant should note that this rejection is over the combination of Kralik in view of Ou. The reference to Kralik teaches that laminating construction liners from fabric and sheet material to form an integral sheet are well known in the art. The reference to Ou teaches that vulcanizing a fabric lining with a rubber sheet to form a panel for a game ball is well known in the art. It would have been obvious to one of ordinary skill in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are directed to inflatable game balls having support panels formed for reinforcing/covering the game ball. Ou particularly teaches advantages for forming his panel from a vulcanized rubber/fabric lining including improved toughness and rigidity. These advantages would also be particularly desirable for the panels taught by Kralik.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the

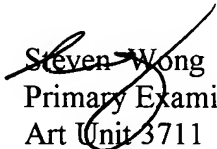
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organization where this application or proceeding is assigned are 703-308-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
March 25, 2003